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Giovanni Nencioni

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EXAMINER

DUCHENEAUX, FRANK D

ART UNIT

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/591,392	<b>Applicant(s)</b> NENCIONI ET AL.	
	<b>Examiner</b> FRANK D. DUCHENEAUX	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 63-126 is/are pending in the application.
- 4a) Of the above claim(s) 86-126 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 63-85 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I, claims 63-85 in the reply filed on 6/26/2009 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

2. Claims 86-124 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 6/26/2009.

Newly submitted claim 125 is directed to an invention that lacks unity with the invention originally claimed for the following reasons: Claim 125 recites, 1) first areas, and second areas corresponding to at least some of the protuberances defining said second areas, which are not required by the original invention; 2) said first areas and said second areas being at least partly staggered to one another, which is not required by the original invention; 3) said third ply is alternatively bonded at said first area to said first ply and at said second area to said second ply, which is not required by the original invention; 4) first and second decorative elements are different in shape from each other, which is not required by the original invention; 5) in areas (not necessarily second areas) on the second ply corresponding to said first decorative elements,

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the second ply is devoid of said second decorative elements or said second decorative elements thereat are flattened, which is not required by the original invention (it is noted that claim 63 requires areas in the second ply be devoid of flattened protuberances, while claim 125 requires that there be no second decorative elements or that said elements be flattened).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 125 is withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Newly submitted claim 126 is directed to an invention that lacks unity with the invention originally claimed for the following reasons: Claim 126 recites, 1) first areas; which is not required by the original invention; 2) first and second decorative elements are different in shape from each other, which is not required by the original invention; 3) in areas (not necessarily second areas) on the second ply corresponding to said first decorative elements, the second ply is devoid of said second decorative elements or said second decorative elements thereat are flattened, which is not required by the original invention (it is noted that claim 63 requires areas in the second ply be devoid of flattened protuberances, while claim 126 requires that there be no second decorative elements or that said elements be flattened).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 126 is withdrawn from consideration as being directed to a nonelected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

*Response to Amendment*

3. Applicant's arguments, see page 22, filed 6/26/2009, with respect to objection to the specification have been fully considered and are persuasive. The objection of the specification has been withdrawn.

4. Applicant's arguments, see pages 22-25, filed 6/26/2009, with respect to the rejection of claims 63-84 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph have been fully considered and are persuasive. The rejection of claims 63-84 has been withdrawn; however, the examiner respectfully disagrees with the applicants' argument in regards to the rejection of claim 85 (see Response to Arguments below).

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. **Claims 63-85** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant

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art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Amended claim 63 recites that the first decorative elements and second decorative elements are distributed with respect to each other so that decorative elements of one pattern do not damage decorative elements of another pattern. Page 10, lines 6-11 specifically discloses that the decorative patterns formed by projections 25P on ply V2 (second ply) will not be damaged, however, there is no disclosure of decorative patterns of V1 (first ply) being undamaged.

The cited phraseology clearly signifies a “negative” or “exclusionary” limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

The insertion of the above phraseology as described above positively excludes “damaged” decorative patterns of either the first or second type; however, there is no support in the present specification for such exclusions. While the present specification is silent with respect to first decorative elements that are not damaged is noted that as stated in MPEP 2173.05(i), the “mere absence of a positive recitation is not the basis for an exclusion.”

Amended claim 63 recites areas in said second ply corresponding to said areas in the first ply are devoid of any protuberance or flattened protuberance. The applicants’ attention is directed to

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page 5, lines 8-11 of the specification wherein it is positively recited that protuberances of the second decorative elements may be flattened; figure 3, wherein areas of the second ply (V2) contain protuberances, albeit those of the background pattern, in said areas (P1) of the first ply (V1); and page 5, lines 5-7, *inter alia*, wherein it is disclosed that the background embossing of the second ply is flattened at a level of the protuberances forming the first decorative element on the first ply.

The cited phraseology clearly signifies a “negative” or “exclusionary” limitation for which the applicants have no support in the original disclosure. Negative limitations in a claim which do not appear in the specification as filed introduce new concepts and violate the description requirement of 35 USC 112, first paragraph, *Ex Parte Grasselli, Suresh, and Miller*, 231 USPQ 393, 394 (Bd. Pat. App. and Inter. 1983); 783 F. 2d 453.

The insertion of the above phraseology as described above positively excludes a protuberance or flattened protuberance in areas of the second ply corresponding to said areas (said areas of the first ply having protuberances P1) in the first ply; however, there is no support in the present specification for such exclusions. While the present specification is silent with respect to protuberances or flattened protuberance being devoid in said areas, is noted that as stated in MPEP 2173.05(i), the “mere absence of a positive recitation is not the basis for an exclusion.”

Amended claim 63 recites that the first ply and the second ply are adhesive-bonded to one another at least at said areas where said first adhesive is applied. The examiner notes that the

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specification provides no support for the first and second plies to be adhesive-bonded, or glue-bonded, to each other; only that each ply is glued to a third, interposing ply.

Amended claim 69 recites the limitation “protuberances having a height...” It is noted that MPEP 2111.03 equates “having” with the open language of “comprising.” The current specification does not provide support for such open language to be applied to the heights of the protuberances.

As such, those amended portions of current claims 63 and 69 cited above constitute new matter.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. **Claims 63-85** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Regarding claim 63**, the claim is indefinite as the claim recites two contradictory limitations; the claim recites “a third ply is interposed between said first ply and said second ply” and further recites “the first ply and the second ply are adhesive-bonded to one another.” The examiner notes that it would be impossible for the first and second plies, within the scope of the limitations of the current claim, to be bonded to one another with an intervening layer between them.



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9. **Claim 85** recites the limitation "the first outer surface of the roll" in lines 2-3. There is insufficient antecedent basis for this limitation in the claim.

**Regarding claim 85**, said claim is indefinite as it is unclear from the claim limitations precisely where the axis is relative to the roll and therefore it is unclear how a straight line parallel to said axis is oriented. Consequently, it is indefinite as to how the decorative elements are positioned respective of the roll (see Response To Arguments below).

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. **Claims 63-68, 76, 79-81, and 79-85** are rejected under 35 U.S.C. 102(b) as being anticipated by Roussel et al. (US Patent 6599614 B1).

**Regarding claim 63**, Roussel teaches a three ply absorbent paper product (title) comprising external first and second embossed plies including salient patterns (first and second patterns) having at least in part discrete protrusions (first and second decorative elements/protuberances) pointing inward of the structure and a central ply (column 3, lines 3-9) whereby in an essential feature of the invention, each of the embossed external plies is adhesively bonded via the distal

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surfaces (interposed) of the protrusions to the central ply and that the embossed external plies have a pattern density exceeding 30 protrusions /cm<sup>2</sup> (3 elements/cm<sup>2</sup> with greater than or equal to one protuberance/element)(column 3, lines 10-13). Roussel also teaches that the plies are assembled by adhesively bonding (first adhesive) the distal surfaces (areas where 1<sup>st</sup> adhesive is applied) of at least a portion (some) of the protuberances of each of the external plies (first ply included) to the central ply (column 3, lines 7-12). Roussel further teaches that the pattern density of the external plies varies from one to the other (column 3, lines 26-27) and that the external second embossed ply includes protrusions distributed at a specific constant pitch, which differs from that of the protrusions of the first ply (column 4, lines 53-56). Roussel teaches that the three plies are mutually bonded (1<sup>st</sup> and 2<sup>nd</sup> plies are adhesive-bonded to one another) (column 4, line 51). The examiner notes that Fig. 1 of Roussel teaches protrusions of the 1<sup>st</sup> and 2<sup>nd</sup> outer plies are distributed with respect to one another and that none of the protrusions are damaged and further that protrusions of the 2<sup>nd</sup> ply near to (corresponding) protrusions of the 1<sup>st</sup> ply are devoid of flattened protrusions.

**Regarding claims 64-65**, Roussel teaches a feature of embossing a first and second ply with salient patterns of discrete protrusions and superposing a third unembossed ply on the protrusions of the first of the embossed plies and depositing (applied) an adhesive (first adhesive) on the third ply (corresponding to said at least some of the protuberances defining the first decorative elements) and assembling the superposed first ply and third ply to the second embossed ply, whereby the deposition of the adhesive on the third ply is such that part of the

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adhesive crosses (seeps) the third ply and allows bonding of all three plies to each other (column 3, lines 47-67 and column 4, lines 1-3).

Although Roussel does not disclose the limitation “made to seep” as recited in claim 65, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Roussel meets the requirements of the claimed structure, Roussel clearly meets the requirements of the present claims.

**Regarding claims 66-68**, Roussel teaches a hot melt glue is atomized onto the inner surface of the external embossed plies (first and second adhesive), whereupon the third ply is sandwiched between the external plies and the set is assembled into a web (column 8, lines 41-44) and further that the adhesive can be applied over the full surface (at least some of the protuberances) of the plies or only partially (column 8, lines 45-47). Roussel also teaches that one (first ply) of the

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plies includes combined patterns, one of which is the background pattern (column 3, lines 31-33).

**Regarding claim 76**, Roussel teaches a central or third smooth or unembossed ply (column 4, lines 50-51 and figure 1, reference number 4).

**Regarding claims 79-81**, Roussel teaches that each ply (first, second and third ply) includes one or more layers forming a laminate (two or more layers) (column 5, lines 12-13).

Although Roussel does not disclose mechanical ply-bonding as recited in claim 80, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Roussel meets the requirements of the claimed structure, Roussel clearly meets the requirements of the present claims.

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**Regarding claim 82**, Roussel teaches a product having a differential delamination strength by embossing a first and second ply with protrusions, superposing a third unembossed ply on the protrusions of the first ply, depositing an adhesive on the third ply and assembling the superposed plies to the second ply by applying sufficient pressure to ensure bonding of the three plies by means of adhesive (column 3, lines 48-62).

**Regarding claims 84-85**, Roussel teaches a web of said invention in roll form (column 5, lines 54-59) as well as having external plies with patterns (decorative elements) and different pitches in the direction of advance and in the transverse direction (symmetric)(column 5, lines 29-30).

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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14. **Claims 69-74** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roussel et al. (US Patent 6599614 B1) in view of Laurent et al (US Patent 6106928) and in further view of Biagiotti (US Patent 6755928 B1).

**Regarding claims 69-73**, Roussel teaches a three ply absorbent paper product as in the previous rejections of claims 63-68 annotated above. Roussel also teaches that the two combined patterns (made up of protrusions, see figure 1 for protrusion's geometric form) have different elevations (column 3, lines 31-35). Roussel fails to teach a second ply with a background pattern, a first ply and a second ply with protuberances of equal to or greater than 8 protuberances/cm<sup>3</sup>, or a background of said second ply wherein the protuberances of a background pattern are of a height less than the protuberances forming said second decorative pattern. Roussel is silent towards a background pattern of a second ply that is flattened at a level of the protuberances of the forming the first decorative elements of said first ply.

However, Laurent teaches an embossed absorbent paper having combined patterns (title) said paper comprising a stratified sheet composed of at least two plies of paper that were embossed separately before being joined (column 4, lines 30-32), whereby each comprises, on its side facing into the stratum, first and second protrusions, respectively, arrayed in a first and a second pattern (column 4, lines 36-38) with said second pattern being a background pattern (column 3, lines 32-33). Laurent continues to teach that the height of the second protrusions is less than that of the first protrusions (column 4, lines 52-54) with the second protrusions arrayed at a rate of at least 30/cm<sup>2</sup> (column 3, lines 39-42). Laurent further teaches a background pattern ensuring

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technical background contribution of thickness and adsorption (column 3, lines 50-52) as well as an eye pleasing textile look because of the high density of the protrusions of the background pattern (column 3, lines 54-56) and provides a contrast for the main pattern (column 3, lines 59-62).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the multiply paper as taught by Roussel with outer plies comprising background patterns of specific density on both outer plies to obtain a product with improved thickness, absorption and aesthetic appeal as in the present invention.

**Regarding claim 74**, Roussel and Laurent teach an absorbent paper product as in the previous rejections of claims 63-71 annotated above. Roussel and Laurent are silent towards a background pattern of a second ply that is flattened at a level of the protuberances forming the first decorative elements of said first ply.

However, Biagiotti teaches an embossed web material and product (title) comprising a first layer (first ply) furnished with a background layer made up of a first set of protuberances ; and a second set of protuberances (first decorative elements) superimposed on the first set, whereby the first layer is coupled to a second layer via gluing and said second layer may be smooth, embossed with a background pattern, embossed with an ornamental motif or embossed both with a background pattern and an ornamental motif (column 2, lines 33-49). Biagiotti continues to teach that the embossment process yields a final web material whereby the second set of

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protuberances flattens the background embossments of the second layer (column 9, lines 19-27 and figures 7 and 11 reference numbers P5 and P3).

It would have, therefore, been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Biagiotti with those of Roussel and Laurent to obtain a multi-ply paper product comprising protuberances of a first ply to extend inward of the product thereby compressing the background protuberances of a second ply in order to provide the final product with adhesion between all the protuberances of greatest depth and increased crush resistance.

15. **Claim 75** is rejected under 35 U.S.C. 103(a) as being unpatentable over Roussel et al. (US Patent 6599614 B1) in view of Graff et al (US 2005/0034828).

**Regarding claim 75**, Roussel teaches a three ply absorbent paper product as in the previous rejections of claim 63. Roussel fails to teach a web material wherein at least some of the protuberances defining second decorative elements are flattened at a level of respective protuberances defining said first decorative elements.

However, Graff teaches a multi-layer sheet of absorbent paper comprising an embossed first ply comprising first and second protrusions (para. 0036 and figure 2, reference numbers 12, 18 and 38, respectively), whereby all the tops (figure 2, reference number 39) of the first protrusions are adhesively bonded to the unembossed (flattened) second ply (figure 2, reference number 14).



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Although Graff does not disclose “flattened protuberances forming second decorative elements”, it is noted that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process”, *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, “although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product”, *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently claimed process and given that Graff's unembossed (flattened) second ply structure meets the requirements of the claimed composition, Graff clearly meets the requirements of the present claims.

It would have, therefore, been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Graff with those of Roussel to obtain a multi-ply paper product comprising first protuberances of a first ply to extend inward of the product thereby allowing for adhesive contact between all of said first protuberances and said second ply as well as mitigating crush resistance degradation.

16. **Claims 77-78** are rejected under 35 U.S.C. 103(a) as being unpatentable over Roussel et al. (US Patent 6599614 B1) in view of Hollenberg et al (US Patent 6221211 B1).

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**Regarding claims 77-78**, Roussel teaches a three ply absorbent paper product as in the previous rejections of claim 63. Roussel fails to teach a third ply with color or a printed pattern.

However, Hollenberg teaches multi-ply tissues having internal indicia (title) comprising a multi-ply tissue comprising two outer plies and one center ply, said center ply containing colored or patterned indicia which is visible through both outer plies (column 1, lines 49-52) and also suitable are solidly colored center plies (column 2, lines 19-21). Hollenberg continues to teach facial and bath tissues provided with a distinctive visual cue or indicator accomplished by printing, dyeing or otherwise coloring an internal surface of one or more plies of a multi-ply tissue, which indicates that such tissues contain unique ingredients or properties (column 1, lines 20-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the central ply as taught by Roussel with a printed pattern or coloration as taught by Hollenberg in order to further provide decorative features to said absorbent paper as in the present invention.

17. **Claim 83** is rejected under 35 U.S.C. 103(a) as being unpatentable over Roussel et al. (US Patent 6599614 B1) in view of Biagiotti (US Patent 6755928 B1).

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**Regarding claim 83**, Roussel teaches a three ply absorbent paper product as in the previous rejections of claims 63 and 66. Roussel fails to teach a first and second adhesive that chromatically different from each other.

However, Biagiotti teaches a method and device for producing an embossed web material and product made (title) wherein the method includes producing a soft product and increasing the decorative effect of the embossing by combining it with the use of colored adhesives (column 2, lines 22-26) so that ornamental motifs stand out from the background of the web material.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine a plurality of colored adhesives as taught by Biagiotti with the inventive concepts as taught by Roussel to obtain a more decorative absorbent paper with varied chromatic possibilities as in the present invention.

### ***Response to Arguments***

18. Applicant's arguments, see page 25, filed 6/26/2009 with respect to the rejection of claim 85 under 35 U.S.C. 112, 2<sup>nd</sup> paragraph have been fully considered but they are not persuasive. The examiner notes that an object can essentially have a limitless number of axes upon which said object can rotate and it is upon this precept that the indefiniteness of the current claim rests. Without a well-defined axis relative to the roll of the present invention, it is impossible to definitively, and without ambiguity, determine how the decorative elements are positioned

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relative to the roll. As such, the rejection is maintained and repeated above subject to the applicants' current amendment.

19. Applicant's arguments, see page 26-28, filed 6/26/2009 with respect to the rejection of claim 63 over Roussel et al. under 35 U.S.C. 102(b) have been fully considered but they are not persuasive. The examiner's complete response to arguments follows:

The applicants assert that that current claim 63 recite 1st and 2nd decorative elements having a density of less than or equal to 3 elements/cm<sup>2</sup> while the Roussel reference teaches that at least one of the external plies has a pattern density exceeding 30 protrusions/cm<sup>2</sup>.

The applicants' attention is directed to the rejection of claim 63 as set forth above and to page 23 of the applicants' current arguments regarding the indefiniteness rejection of the current claim, wherein the applicants state that decorative elements have a density of no more 3 elements/cm<sup>2</sup> and that each of the decorative elements are in turn formed of at least one protuberance. It is noted that the claim language of "at least one" provides no upper limit to the number of protrusions that form a decorative element. As stated in the rejections set forth in the previous action and repeated above, the Roussel reference teaches embossed external plies having a pattern density exceeding 30 protrusions/cm<sup>2</sup>, which necessarily anticipates a decorative pattern having no upper limit to the number of protrusions forming said decorative pattern. In essence, the current claim recites a density of a decorative pattern while the Roussel reference recites a density of protrusions forming a pattern. Further, the pattern having said protrusion

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density as taught by Roussel provides a pattern formed of 30 protrusions per each square centimeter, which necessarily provides at least one pattern (less than 3 patterns) every square centimeter as presently claimed. It is also noted that a pattern of embossments necessarily constitutes an element and that the decorative merits of the pattern is of a relative perception.

The applicants' also argue that the decorative elements are distributed with respect to one another so that decorative elements of one pattern (of a an outer ply) do not damage the decorative elements of another pattern (of the other outer ply) and that therefore, the decorative elements (of each of the outer plies) are out of phase with each other when the plies are joined. The applicants assert that Roussel teaches that gluing is obtained by pressing the protrusions of one ply against the protrusions of the other ply and that such a protrusion arrangement does not provide a random arrangement of the protrusion with respect to one another, i.e. that the protrusions are in phase with one another. Additionally, applicants refer to figures 3 and 7 of the drawings of the present application, which applicants assert demonstrates a bonding correspondence with the protuberances P1 forming the first decorative elements on the 1<sup>st</sup> ply V1 and/or in correspondence with the protuberances P3 forming the decorative elements on ply V2, and that the two plies are randomly arranged in the sense that there is no necessary mutual correspondence between P1 and P3.

The examiner notes, as set forth above in the rejection of claim 63, that the multi-ply embossed configuration provides protrusions on a first outer ply and a second outer ply without either of the corresponding protrusions damaging one another. The examiner further notes that the

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limitations of the current claim do not require that the protrusions be out of phase with one another; only that they are distributed with respect to each other so that the decorative elements, and the protrusions therein, do not damage each other. Clearly, Roussel teaches protrusions on 1<sup>st</sup> and 2<sup>nd</sup> outer plies arranged respective to one another and that said protrusions do not damage one another. The examiner respectfully requests clarification in regards to the latter half of the applicants' arguments paraphrased in the preceding paragraph of the current action (including and following "additionally") as it is unclear whether the applicants are asserting a correspondence between protrusions P1 and P3 or a lack thereof.

The applicants continue to argue that since the decorative elements of the 1<sup>st</sup> ply are different from one another and randomly arranged with respect to one another, it is not possible to join and bond the opposite outer plies V1 and V2 at corresponding protuberances as taught by Roussel and it is further asserted that the decorative elements of the current claim are staggered with respect to one another.

The examiner notes that, within the scope of the disclosed invention and the applicants' arguments thus far, the preceding arguments were intended to assert not that "the decorative elements of the 1<sup>st</sup> ply are different from one another and randomly arranged with respect to one another" but that "the decorative elements of the 1<sup>st</sup> ply are different from the decorative elements of the 2<sup>nd</sup> ply and randomly arranged with respect to one another." The examiner notes that the current claims have been amended to remove the "random" limitation and further, that the claim limitations do not required that protrusions be staggered. Finally, the examiner

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respectfully disagrees that randomly arranged protrusions on the 1<sup>st</sup> and 2<sup>nd</sup> plies makes it impossible to join and bond said protrusions as, by definition, the behavior of a random arrangement can not be predicted. The applicants' attention is directed to page 5, lines 8-11, wherein it is presently disclosed that a random arrangement does provide the possibility for opposing protuberance to contact one another.

20. Applicant's arguments, see pages 29-32, filed 6/26/2009 with respect to the rejections of the claims dependent from current claim 63 over Roussel et al. in view of Laurent et al. and in further view of Biagiotti under 35 U.S.C. 103(a) (current claims 69-74); Roussel et al. in view of Graff et al. under 35 U.S.C. 103(a) (current claim 75); Roussel et al. in view of Hollenberg et al. under 35 U.S.C. 103(a) (current claims 77-78); Roussel et al. in view Biagiotti under 35 U.S.C. 103(a) (current claim 83) have been fully considered but they are not persuasive. The examiner's complete response to arguments follows:

The applicants argue that the process disclosed by Roussel and that currently disclosed are entirely different, wherein the current disclosure yields adhesive-bonded areas in correspondence of the decorative elements P1 on ply V1, corresponding to flattened areas or areas devoid of decorative elements of the 2<sup>nd</sup> ply, which is different from that of Roussel in which gluing spots are necessarily placed in a position where mutually facing protrusions of the outer plies are in a tip-to-tip configuration. The applicants also note the current amendments to claim 63, which recite areas where a 1<sup>st</sup> adhesive is applied and that the 1<sup>st</sup> and 2<sup>nd</sup> plies are adhesive-bonded to

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each other in said areas and that in such areas, the 2<sup>nd</sup> ply is devoid of protuberances or has flattened protuberances.

The examiner directs the applicants' attention to the follow: firstly, although Roussel does not disclose the methods and apparatus as presently disclosed, it is noted that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process", *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) . Further, "although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product", *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983). See MPEP 2113.

Therefore, absent evidence of criticality regarding the presently disclosed process and given that Roussel meets the requirements of the claimed web as set forth in the rejection of claim 63 above and the examiner's previous response to applicants' arguments, Roussel clearly meet the requirements of the present claims.

Secondly, as set forth above, Roussel does teach a first ply and a second ply bonded to one another in areas where an adhesive was applied.

Thirdly, it is noted that the claim limitations of currently amended claim 63 do not recite precisely what applicants have argued; specifically, the claim recites "a first adhesive is applied



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in areas corresponding to at least some of the protuberances defining said first decorative elements” and “areas in said second ply corresponding to said areas in the first ply are devoid of any protuberance or flattened protuberance” (emphasis provided by examiner). It is noted that, as recited, the former limitation does not require said adhesive to be applied in any particular manner; only that it be applied in areas “corresponding” to said protuberances, which does not require that the 1<sup>st</sup> and 2<sup>nd</sup> plies be bonded in any particular manner. It is also noted that, as recited, the latter limitation requires areas of the 2<sup>nd</sup> ply corresponding to said areas of the 1<sup>st</sup> ply be devoid of protuberances OR devoid of flattened protuberances. Clearly, Roussel teaches 1<sup>st</sup> and 2<sup>nd</sup> plies bonded via adhesives in areas where the adhesive was applied and that said areas do not have flattened protuberances on either the 1st or 2nd ply.

The applicants argue that the secondary references applied in combination with the Roussel reference for teaching further elements in the dependent claims of the current application do not make up for the short comings of the Roussel reference and as such, Roussel, either alone or in combination with the secondary references, does not teach or suggest the applicants' claimed web material.

The examiner directs the applicant's attention to the rejection of independent current claim 63 as set forth above, the rejection of the claims depending from claim 63 and the examiner's response to the applicants' arguments as set forth above.

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21. Applicant's arguments, see page 31, filed 6/26/2006 with respect to claims 125-126 have been considered but are moot in view of the applicants' election by original presentation.

The applicants' assert that new claims 125 and 126 are more specifically directed to embodiments of the current disclosure.

The applicants attention is drawn to the "Election/Restriction" section set forth above, wherein the claim limitations of new claims 125 and 126 differ from the limitations of claim 63 and it's dependent claims to an extent requiring a restriction between the inventions of new claims 125 and 126 and the invention of current claim 63 and those dependent on claim 63. The applicants' election by original presentation of the invention drawn to claim 63 et al. is acknowledged.

### ***Conclusion***

22. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FRANK D. DUCHENEAUX whose telephone number is (571)270-7053. The examiner can normally be reached on M-Th, 7:30 A.M. - 5:00 P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie E. Shosho can be reached on (571)272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/F. D. D./

Examiner, Art Unit 1794

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1794